



09 OCT 2007

33717

GREENBERG TRAURIG LLP (LA)
2450 Colorado Avenue, Suite 400E
Intellectual property Department
Santa Monica, CA 90404

In re Application of :
BOWERMAN *et al* :
U.S. Application No.: 10/595,675 :
PCT No.: PCT/GB2004/004419 :
Int. Filing Date: 20 October 2004 :
Priority Date: 04 November 2003 :
Attorney Docket No.: 091350-011600 :
For: TRAFFIC CONTROL BARRIERS :

DECISION

This decision is in response to applicants' "Petition under 37 CFR 1.47(b) to Proceed with Application on Behalf of Nonsigning Inventors" filed 04 September 2007. This petition is treated under 37 CFR 1.47(a).

BACKGROUND

On 14 May 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. Applicants were given two months to respond with extensions of time available.

On 04 September 2007, applicants filed a response which was accompanied by, *inter alia*, the subject petition; a \$130.00 petition fee; a \$65.00 surcharge fee; a one-month extension fee of \$60.00; a declaration signed by three of the five named inventors; a declaration of Jurek J.A. Tolloczko; exhibits A - F; and authorization to charge any additional fees as required to Deposit Account No. 50-2638.

DISCUSSION

Applicants claim that two of the five named inventors refuse to cooperate in the above-identified application and have filed the subject petition in response to the Form PCT/DO/EO/905 mailed 14 May 2007.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor(s) cannot be located or refuse to cooperate; (3) a statement of the last known address(es) of the nonsigning joint inventor(s); (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventor(s). Items (1) and (3) are complete.

Concerning item (1), applicants submitted a petition fee of \$130.00, a one-month extension fee of \$60.00 and a surcharge fee of \$65.00. The charge for a petition under 37 CFR 1.47 changed to \$200.00 on 08 December 2004. Further, a two-month extension of fee time of \$225.00 is required. The difference in fees has been charged to Counsel's Deposit Account No. 50-2638 as authorized. The \$65.00 surcharge fee was previously submitted and has been credited back to the Deposit Account.

With regards to item (3), the last known addresses of both of the nonsigning inventors were recorded on the letters submitted as exhibits C, D and F.

Regarding item (2), applicants' claim that Mr. Gibbs and Mr. Whitton have failed to cooperate in the above-captioned application. In support of this claim, applicants submitted a declaration of Jurek J.A. Tolloczko who states that a copy of the declaration and assignment were sent to both inventors but that no response was received. Copies of the letters and postal receipts were provided as exhibits.

Section 409.03(d) of the MPEP discusses a refusal to cooperate and states, in the relevant section that:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. . . .

Here, petitioners have not shown that a complete copy of the application papers was forwarded to either inventor. The letters submitted as exhibits C, D and F indicate that only a declaration and assignment were enclosed. Therefore, the lack of response by the inventors does not constitute a refusal. Petitioners must provide a complete copy of the application (specification, claims, and drawings) to the inventors before a refusal can be shown.

For this reason, item (2) of 37 CFR 1.47(a) is not yet satisfied.

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by three of the five co-inventors on behalf of themselves and the nonsigning joint inventor. The residence, address and citizenship of the three signing inventors

10/595,675

recorded on the declaration. However, there is no citizenship information for Mr. Gibbs and Mr. Whitton on the declaration. The citizenship information is required by 37 CFR 1.497(a)(3).

For this reason, item (4) of 37 CFR 1.47(a) is also not satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302